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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,435	11/20/2001	Michael H. Jander	24001B	7530
22889	7590	11/26/2003	EXAMINER	
OWENS CORNING 2790 COLUMBUS ROAD GRANVILLE, OH 43023			YAO, SAMCHUAN CUA	
			ART UNIT	PAPER NUMBER

1733

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/993,435

Applicant(s)

JANDER, MICHAEL H.

Examiner

Sam Chuan C. Yao

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 8-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 26-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Group I (claims 1-7) filed on 10-30-03 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### *Oath/Declaration*

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It does not identify the date for which the declaration was executed (i.e. date when the inventor signed the declaration) nor it does provide a title of the present invention. These missing data may be provided on either on an application data sheet or supplemental oath or declaration.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 2 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is confusing, because of the phrase "... **when subsequently compacted**" (bold-face added). **When** the sheet is NOT subsequently compacted, is the recited impregnation of chopped filamentized layer

required or not? In other words, does the limitation in this claim positively require forming a resin impregnated unfilamentized fiber layer or merely require an unfilamentized fiber layer capable of being resin impregnated during a compaction operation. For the purpose of examining this limitation, the limitation in this claim is assumed to require the latter (i.e. capable of being impregnated during a compaction operation).

Claim 27 is indefinite, because the phrase "*said plurality of chopped unfilamentized filamentized fibers*" does not have positive antecedent basis. Equally important, the term "*unfilamentized filamentized*" is not understood.

***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 26-28, 33-34, and 39-40 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Grisch (US 4,207,282) for reasons of record set forth in a prior office action dated 08-28-03, numbered paragraph 10.

**Note: Whether filaments are chopped in a bundle form (i.e. unfilamentized or partially filamentized) or not (i.e. filamentized), the resultant particles are chopped filaments.** For this reason, the limitation of using chopped unfilamentized or partially filamentized fibers fails to structurally define over chopped filamentary fibers taught by Grisch.

"Even though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production." MPEP 2113. It is now well settled, "If the product in the product by process claim is the same as or obvious from the product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In re Thorpe, 777 f.2d 695,698,227 USPQ 964 966 (Fed. Cir. 1985).

Moreover, according to MPEP 2113, "The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessmann, 489 F2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). **Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior**

**art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.** In re Marosi, 710 F.2d 798, 802,218 USPQ 289, 292 (Fed. Cir. 1983).

8. Claims 4-7, 29-32, 35-38, and 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grisch (US 4,207,282) as applied to 1 or 3 above, for reasons of record set forth in a prior office action dated 08-28-03, numbered paragraph 11.

9. Claims 1-7 and 26-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Admitted Prior Art (APA) in view of Stoops et al (US 4,141,929) or Grisch (US 4,207,282) for reasons of record set forth in a prior office action dated 08-28-03, numbered paragraph 12.

#### **Response to Arguments**

10. Applicant's arguments filed on 10-30-03 have been fully considered but they are not persuasive.

Counsel argues on page 15 that *"The present invention ... utilizes unfilamentized (new independent claim 1) or partially filamentized (new independent claim 26) fibers, not filamentized fibers (15) as in the Grisch disclosure."* It should be noted first of all that, the recited claims are directed to product claims. Therefore, it is immaterial whether Grisch fails to teach using chopped *"unfilamentized (new independent claim 1) or partially filamentized (new independent claim 26) fibers"* as long as this

limitation fails to structurally distinguish over chopped filamentized fibers (15) taught by Grisch. **Whether filaments are chopped in a bundle form (i.e. unfilamentized or partially filamentized) or not (i.e. filamentized), the resultant particles are chopped filaments.** For this reason, the recited sheet fails to structurally distinguish over the sheet taught by Grisch. As noted earlier, *"Even though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production."* MPEP 2113.

Counsel argues on page 16 last two paragraphs that, *"Stoops, similar to the prior art and Grisch, does not therefore teach the use of chopped unfilamentized fibers or the use of chopped partially filamentized fibers in addition to a layer of resin impregnated filamentized fibers."* Contrary to Counsel's assertion, as clearly disclosed on page 7 lines 8-16 and illustrated in figures 1B and 2A, just like the presently recited claims, the SMC of the admitted prior art also comprises *"a resin impregnated unfilamentized or partially filamentized fiber layer 16"*. In fact, the only difference between SMC of the APA and the recited SMC in claim 1 is: the APA fails to teach providing a *"resin impregnated filamentized fiber layer"*. However, this limitation (i.e. *"resin impregnated filamentized fiber layer"*) would have been obvious in the art making an SMC taught by APA for reasons set forth in a prior office action dated 08-28-03, numbered

paragraph 12. Examiner also strongly disagrees with Counsel's characterization the Stoops patent and the Grisch patent. As clearly illustrated in figure 1 in the Stoops patent, axially oriented filaments are deposited onto a resin coated film, where they are compressed together in a downstream processing operation. Therefore, the axially oriented filaments must naturally be impregnated with the resin on the film as illustrated in figure 2. More importantly, as clearly as illustrated in figure 3, the Grisch patent teaches using a resin-impregnated filamentary layer.

#### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.




12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (703) 308-4788. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W Ball can be reached on (703) 308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
Sam Chuan C. Yao  
Primary Examiner  
Art Unit 1733

Scy  
11-20-03